

EXHIBIT A

1412.03 Broadening Reissue Claims [R-2]

35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues:

No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.

MEANING OF "BROADENED REISSUE CLAIM"

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the original patent. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are not part of the "original patent" under 35 U.S.C. 251. The Court in *Vectra Fitness Inc. v. TNWK Corp.*, 49 USPQ2d 1144, 1147, 162 F.3d 1379, 1383 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under 35 U.S.C. 251 against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been

sued for infringement. Thus, where the original patent claims only the process, and the reissue application adds (for the first time) product claims, the scope of the claims has been broadened since a party could not be sued for infringement of the product based on the claims of the original patent.

The addition of combination claims in a reissue application where only subcombination claims were present in the original patent could be a broadening of the invention. The question which must be resolved in this case is whether the combination claims added in the reissue would be for "the invention as claimed" in the original patent. See *Ex parte Wikdahl*, 10 USPQ2d at 1549. The newly added combination claims should be analyzed to determine whether they contain every limitation of the subcombination of any claim of the original patent. If the combination claims (added in the reissue) contain every limitation of the subcombination (which was claimed in the original application), then infringement of the combination must also result in infringement of the subcombination. Accordingly, the patent owner **could not**, if a reissue patent issues with the combination claims, **sue any new party** for infringement who could not have been sued for infringement of the original patent. Therefore, **broadening does not exist**, in spite of the addition of the combination.

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SCOPE OF DEPENDENT CLAIM ENLARGED-NOT BROADENING

As pointed out above, a claim will be considered a broadened reissue claim when it is greater in scope than **each and every** claim of the patent to be reissued. A corollary of this is that a claim which has been *broadened in a reissue as compared to its scope in the patent* is not a broadened reissue claim if it is narrower than, or equal in scope to, any other claim which appears in the patent. A common example of this is where dependent claim 2 is broadened via the reissue (other than the addition of a process step to convert an intermediate to a final product as discussed in the preceding subsection), but independent claim 1 on which it is based is not broadened. Since a dependent claim is construed to contain all the limitations of the claim upon which it depends, claim 2 must be at least as narrow as claim 1 and is thus not a broadened reissue claim.

NEW CATEGORY OF INVENTION ADDED IN REISSUE - >GENERALLY NOT< BROADENING

The addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989). >A situation may arise, however, where the reissue application adds a limitation (or limitations) to process A of making the product A claimed in the original patent claims. For example:

(1) a process of using the product A (made by the process of the original patent) to make a product B, disclosed but not claimed in the original patent; or

(2) a process of using the product A to carry out a process B disclosed but not claimed in the original patent.

Although this amendment of the claims adds a method of making product B or adds a method of using product A, this is not broadening (*i.e.*, this is not an enlargement of the scope of the original patent) because the 'newly claimed invention' contains all the limitations of the original patent claim(s).<

WHEN A BROADENED CLAIM CAN BE PRESENTED

A broadened claim can be presented within two years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing reissue application after the two year period. In any other situation, a broadened claim cannot be presented, and the examiner should check carefully for the improper presentation of broadened claims.

A reissue application filed on the 2-year anniversary date from the patent grant is considered to be

filed within 2 years of the patent grant. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

See also the following cases which pertain to broadened reissues:

In re Graff, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under 35 U.S.C. 251 because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original patent and the public was not notified that broadened claims were being sought until after the two-year period elapsed.);

In re Fotland, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) (The failure by an applicant to include *an oath or declaration indicating a desire to seek broadened claims* within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. Under the former version of 37 CFR 1.175 (the former 37 CFR 1.175(a)(4)), applicant timely sought a "no-defect" reissue, but the Court did not permit an attempt made beyond the two year limit to convert the reissue into a broadening reissue. In this case, applicant did not indicate any intent to broaden within the two years.);

In re Bennett, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (*en banc*) (A reissue application with broadened claims was filed within two years of the patent grant; however, the declaration was executed by the assignee rather than the inventor. The Federal Circuit permitted correction of the improperly executed declaration to be made more than two years after the patent grant.);

In re Doll, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970) (If the reissue application is timely filed within two years of the original patent grant and the applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.).

Form paragraphs 14.12 and 14.13 may be used in rejections based on improper broadened reissue claims.

¶ 14.12 *Rejection, 35 U.S.C. 251, Broadened Claims After Two Years*

Claim [1] rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

¶ 14.13 *Rejection, 35 U.S.C. 251, Broadened Claims Filed by Assignee*

Claim [1] rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

BROADENING REISSUE - OATH/DECLARATION REQUIREMENTS

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors. See also MPEP § 1414. If a supplemental oath or declaration in a broadening reissue application is needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath or declaration must be signed by all of the inventors. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999) and MPEP § 1414.01.

1412.04 Correction of Inventorship [R-2]

The correction of misjoinder of inventors has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814, 815 (Bd. App. 1971) wherein the Board held that 35 U.S.C. 251 authorizes reissue applications to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate. See also *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B

was permitted in a reissue application. The court noted that reissue by itself is a vehicle for correcting inventorship in a patent.

CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP

While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of 35 U.S.C. 256 and 37 CFR 1.324 by filing a request for a Certificate of Correction if:

(A) the only change being made in the patent is to correct the inventorship; and

(B) all parties are in agreement and the inventorship issue is not contested.

See MPEP § 1481 for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.

REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

Where the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, a reissue application is the appropriate vehicle to correct inventorship. The failure to name the correct inventive entity is an error in the patent which is correctable under 35 U.S.C. 251. The reissue oath or declaration pursuant to 37 CFR 1.175 must state that the applicant believes the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and that such error arose without any deceptive intention on the part of the applicant. The reissue oath or declaration must, as stated in 37 CFR 1.175, also comply with 37 CFR 1.63.

The correction of inventorship does not enlarge the scope of the patent claims. Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885,

EXHIBIT B

ing aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the “broadening aspect” to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See MPEP § 1412.02.

1412.03 Broadening Reissue Claims

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MEANING OF “BROADENED REISSUE CLAIM”

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the original patent. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are not part of the “original patent” under 35 U.S.C. 251. The Court in *Vectra Fitness Inc. v. TNWK Corp.*, 49 USPQ2d 1144, 1147, 162 F.3d 1379, 1383 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under 35 U.S.C. 251 against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed.

A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least*

one respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement. Thus, where the original patent claims only the process, and the reissue application adds (for the first time) product claims, the scope of the claims has been broadened since a party could not be sued for infringement of the product based on the claims of the original patent.

The addition of combination claims in a reissue application where only subcombination claims were present in the original patent could be a broadening of the invention. The question which must be resolved in this case is whether the combination claims added in the reissue would be for “the invention as claimed” in the original patent. See *Ex parte Wikdahl*, 10 USPQ2d at 1549. The newly added combination claims should be analyzed to determine whether they contain every limitation of the subcombination of any claim of the original patent. If the combination claims (added in the reissue) contain every limitation of the subcombination (which was claimed in the original application), then infringement of the combination must also result in infringement of the subcombination. Accordingly, the patent owner could not, if a reissue patent issues with the combination claims, sue any new party for infringement who could not have been sued for infringement of the original patent. Therefore, broadening does not exist, in spite of the addition of the combination.

BROADENING-INDIRECT INFRINGEMENT

35 U.S.C. 271(g). *Infringement of patent*

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after —

- (1) it is materially changed by subsequent processes; or
- (2) it becomes a trivial and nonessential component of another product.

An unusual type of broadening may arise where the patent owner adds, in the reissue, a limitation to the original patent claims which were drawn to a process of making an intermediate, so as to now claim in the reissue application a process of making a final product. In *Eli Lilly and Co. v. American Cyanamid Co.*, 82 F.3d 1568, 1577, 38 USPQ2d 1705, 1712 (Fed. Cir. 1996), the court noted that a patent holder having claims to preparing an intermediate compound is unable to successfully pursue an accused infringer who is importing for sale the final product, where the accused infringer has “materially changed” the intermediate by converting it into the final product. Thus, where a patent claims a method of making new intermediate product ABC, the patent owner will not be able to prevent a competitor from importing the final product ABCD for the purpose of selling it in the United States. If, however, the patent claims could be modified by reissue to include a claim to preparing the final product ABCD, then the patent owner would, in fact, be able to prevent a competitor from importing the final product ABCD because that importation would (indirectly) infringe the patent under 35 U.S.C. 271(g). The amendment of the patent claims in the reissue application to include a final step of converting the intermediate ABC to the final product ABCD would enable the patent owner to invoke the protection of 35 U.S.C. 271(g), thereby increasing the scope of protection of the patent claims so that a new set of infringers would be created.

As pointed out above, a reissue claim is broadened if it contains within its scope any conceivable invention which would not have infringed the patent, but will now infringe the reissue claim. Thus, when the new reissue claims drawn to producing the final product ABCD are subjected to the test for broadening, as set forth by the Court of Appeals for the Federal Circuit in *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (1987)(citing *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982); *In re Ruth*, 287 F.2d 729, 126 USPQ 155 (CCPA 1960)), they indeed provide the patent owner with expanded protection. If the reissue is granted, the patent owner would be able to exclude an infringer whom the patent owner was unable to exclude heretofore by relying on the claims in the original patent.

The inclusion of an additional step in a chemical process claim would generally appear to narrow the scope of that claim. A process claim having more steps is usually considered to be narrower than one reciting fewer steps. Accordingly, the addition of a process step to convert intermediate ABC into the final product ABCD might initially appear to be solely a narrowing of the claims. Through the provisions of 35 U.S.C. 271(g), however, what appears to be solely a narrowing limitation in actuality also provides an element of broadening to the claim because it provides an additional element of protection for the patent owner which did not exist prior to the insertion of the limitation.

In a chemical case where process claims are present, the examiner should be careful to check the claims for the presence of this unique type of broadening.

SCOPE OF DEPENDENT CLAIM ENLARGED-NOT BROADENING

As pointed out above, a claim will be considered a broadened reissue claim when it is greater in scope than **each and every** claim of the patent to be reissued. A corollary of this is that a claim which has been *broadened in a reissue as compared to its scope in the patent* is not a broadened reissue claim if it is narrower than, or equal in scope to, any other claim which appears in the patent. A common example of this is where dependent claim 2 is broadened via the reissue (other than the addition of a process step to convert an intermediate to a final product as discussed

in the preceding subsection), but independent claim 1 on which it is based is not broadened. Since a dependent claim is construed to contain all the limitations of the claim upon which it depends, claim 2 must be at least as narrow as claim 1 and is thus not a broadened reissue claim.

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BROADENING REISSUE - OATH/DECLARATION REQUIREMENTS

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1412.04 Correction of Inventorship

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CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP

While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of 35 U.S.C. 256 and 37 CFR 1.324 by filing a request for a Certificate of Correction if:

(A) the only change being made in the patent is to correct the inventorship; and

(B) all parties are in agreement and the inventorship issue is not contested.

See MPEP § 1481 for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.

REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

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The correction of inventorship does not enlarge the scope of the patent claims. Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885, (D.D.C. 1995). See 35 U.S.C. 251, third paragraph. Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee of the entire interest signs the reissue oath/declaration. Accordingly, an assignee of the entire interest can add or delete an inventor by reissue (e.g., correct inventorship from inventor A to inventors A and B) without the original inventor's consent. See also 37 CFR 3.71(a) ("One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or